

PATENT *an*

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2 June 1997  
Date

Carol Nottenburg  
Carol Nottenburg, Ph.D.

10530 U.S. PTO  
09/132231  
06/11/96

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Dipak K. Dube, Marshall S. Horwitz, and Lawrence A. Loeb  
Application No. : 08/316,415  
Filed : September 30, 1994  
For : METHOD FOR PRODUCING NOVEL DNA  
SEQUENCES WITH BIOLOGICAL ACTIVITY  
Examiner : Scott D. Priebe, Ph.D.  
Art Unit : 1805  
Docket No. : 920010.690  
Date : May 5, 1997

Assistant Commissioner for Patents  
2011 Jefferson Davis Highway  
Washington, DC 20231

CONSENT UNDER 37 C.F.R. § 1.48(a)

Sir:

I, Robert C. Miller, Ph.D., Director of the Office of Technology Transfer for the University of Washington, the assignee in the above-identified patent application, hereby consent to the removal of Dipak K. Dube as an inventor as presented in the attached Petition Under 37 C.F.R. § 1.48(a).

Robert C. Miller  
Robert C. Miller, Ph.D.  
Director of Office of Technology Transfer

Date: May 21, 1997

CN:asl

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Examiner : Scott D. Priebe, Ph.D.  
Art Unit : 1805  
Docket No. : 920010.690  
Date : May 29, 1997

Assistant Commissioner for Patents  
2011 Jefferson Davis Highway  
Washington, DC 20231

VERIFIED STATEMENT OF FACTS

Sir:

We, Dipak K. Dube, Marshall S. Horwitz, and Lawrence A. Loeb, do declare:

1. We are the originally named inventors on United States Application No. 08/316,415, filed September 30, 1994 ("present application"), which has been assigned to the University of Washington. We make this declaration for the purpose of removing Dipak K. Dube as a joint inventor in the present application.

2. The true inventors of the claimed subject matter in the present application are Marshall S. Horwitz and Lawrence A. Loeb. The application, as originally filed, inadvertently, and without deceptive intent, included Dipak K. Dube as a joint inventor.

3. The issue of naming Dipak K. Dube as an inventor was discovered on or approximately November 10, 1995, in a conference between Marshall S. Horwitz and applicants' attorneys. During this conference, Dr. Horwitz delineated the actual role of the three named inventors in conceiving of the invention and reducing it to practice. While Dr. Horwitz and Dr. Loeb co-invented the instant invention by each making inventive contribution, the experiments Dr. Dube performed experiments that did not contribute

conceptually to the invention as claimed or add inventiveness in reducing the claimed invention to practice.

4. The change in inventorship occurred on or around June 19, 1989, when Dr. Dube was listed as an inventor on a filing of a prior related application, i.e., a continuation-in-part application (United States Application No. 07/368,674, filed June 19, 1989) of the parent application (United States Application No. 06/887,070, filed July 17, 1986). Dr. Dube contributed to the new matter inserted as an example in the continuation-in-part, but this new matter was not the subject of any claims. A declaration was subsequently signed by all three named inventors under the mistaken impression that the addition of this subject matter warranted inventorship. The criteria for evaluating inventorship was not adequately explained or fully appreciated by the named inventors. This misunderstanding occurred without any deceptive intent on the part of the actual inventors.

5. We request that the inventorship of the present application be amended to recite Marshall S. Horwitz and Lawrence A. Loeb.

We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of any patent issuing from this patent application.

Dipak K. Dube

5/29/97  
Date

Marshall S. Horwitz

5-29-97  
Date

Lawrence A. Loeb

5-29-97  
Date

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